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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,454	09/30/2003	Rick M. Miller	2276/2	5614
23381	7590	02/15/2005	EXAMINER	
DORR CARSON SLOAN & BIRNEY, PC			WONG, STEVEN B	
3010 EAST 6TH AVENUE			ART UNIT	
DENVER, CO 80206			PAPER NUMBER	
			3711	

DATE MAILED: 02/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/675,454	Applicant(s) MILLER ET AL.	
	Examiner Steven Wong	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2004.  
 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.  
     4a) Of the above claim(s) 3,4,7-9 and 12 is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1,5,6,10,11,13 and 15 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 5, 6, 10, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyt et al. (5,419,551). Note the basis for the rejections set forth in the first Office Action. Further, the limitation for the ball marker to be substantially disc-shaped body having a substantially circular perimeter is rendered obvious by the teachings of Hoyt et al. in that it would have been obvious to one of ordinary skill in the art to form the tool of Hoyt in a circular shape in order to reduce the number of edges of the tool and facilitate insertion of the tool in the user's pocket. The substantially flat tool structure and the modified circular shape would comprise the claimed "disc-shaped body". Further, the limitation for the ball marker to be disc-shaped and with a circular perimeter is considered to be an obvious change in shape or form of the prior art. See *In re Dailey et al.* 149 USPQ 47.
3. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyt et al. (5,419,551) in view of Hardin et al. (5,449,169). Note the basis for the rejections set forth in the first Office Action.

***Response to Arguments***

4. Applicant's arguments have been fully considered but are not deemed to be persuasive. The applicant contends that the reference to Hoyt does not teach a ball marker having a disc-shaped body with a circular perimeter and a prod that is retractable to a position within the circular perimeter. However, this is not persuasive as the limitation for the shape of the ball marker to be disc-shaped with a circular perimeter is considered to be an obvious change in

Art Unit: 3711

shape of the tool of Hoyt. See *In re Dailey et al.* 149 USPQ 47. A convincing argument is not provided by applicant showing that the particular configuration of their tool is significant or is anything more than one of the numerous configurations that a person of ordinary skill in the art would find obvious given the teachings of Hoyt. While Hoyt did not specifically state the possibility for forming his body in a circular shape, there is nothing in the disclosure of Hoyt to preclude one of ordinary skill in the art from modifying the body in this shape. Applicant's statement that the scoring wheel of Hoyt would not function with a circular body shape is subjective and not based on any factual evidence.

Regarding applicant's arguments that Hoyt does not contemplate the use of his tool as a ball marker and actually provides a ball marker (26), these arguments are not persuasive as neither one would preclude one of ordinary skill in the art from using the tool of Hoyt as a ball marker. The limitation for the "ball marker" relates to the intended use of the body member and as long as Hoyt provides a body that is capable of performing that function then he meets the limitation. The claim fails to provide any further limitations for the language "ball marker" other than it is disc-shaped and has a circular perimeter. Clearly, the tool of Hoyt when modified as set forth above meets these limitations.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

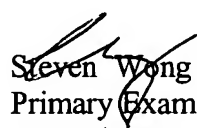
Art Unit: 3711

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Steven Wong  
Primary Examiner  
Art Unit 3711

SBW  
February 10, 2005